

REMARKS/ARGUMENTS

The Office Action dated July 16, 2003 has been carefully reviewed and these remarks are responsive thereto. Claims 3-28 and 31-55 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested based on the following arguments.

Rejections under 35 U.S.C. § 103

Claims 3-4, 6-7, 9-15, 21-22, 24, 26-28, 31, 33-34, 36-44, 46-47, and 50-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,794,259 to Kikinis, issued August 11, 1998, in view of U.S. Patent No. 6,192,380B1 to Light et al., issued February 29, 2001.

Applicants respectfully traverse this rejection for at least the following reasons. In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See MPEP § 706.02 (j); In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Independent Claim 3 recites, *inter alia*, “displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user.” Neither Kikinis nor Light et al. teaches or suggests this claimed element. In Kikinis, if the field identifier of the selected field matches a previously stored identifier, Kikinis fills in the one associated data value automatically. Kikinis does not display a list of suggested data values as recited in the claim. In Kikinis, if the two identifiers do not match, the user can ask that a list of tags be displayed, but tags are not data values. That is, a tag is a variable name, whereas a data value represents the value of that variable. Thus, a list of data values previously stored in response to one or more different forms is never displayed, only a list of tags is ever displayed. Similarly, Light et al. does not display a list of suggested data values previously stored in response to one or more different forms.

Claim 3 also recites, *inter alia*, “in response to the user selecting one of the suggested data values, copying the data value selected by the user into the data entry region of the selected field.”

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Neither Kikinis nor Light et al. teaches or suggests this claimed element. In Kikinis, the user selects a tag (i.e. field identifier); the single data value associated with the selected tag is then copied into the data field. What is copied (a data value) is not the same as what is selected (a tag). Similarly, Light et al. does not suggest a list of data values to the user; therefore, there is no data value for the user to select.

Claim 3 also recites, *inter alia*, “detecting a user-initiated action and inhibiting the copying of the suggested data value into the data entry region until after receipt of the user initiated action.” Neither Kikinis nor Light et al. teaches or suggests this claimed element. In Kikinis, the data value that is copied is not what is suggested to the user. In Light et al., while the user may be queried whether it is acceptable to fill in the data (see Light et al., col. 6, lines 25-26), the data that is filled in is never suggested to the user beforehand. Because the combination of Kikinis and Light does not teach or suggest all the claim elements, the rejection of claim 3 is respectfully traversed.

Claims 4, 6, 9, 11-15, 21, 31, 33, 36, 38-44, 46, 52, and 54, as with Claim 3, recite, *inter alia*, “displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user; in response to the user selecting one of the suggested data values, copying the data value selected by the user into the data entry region of the selected field.” These claims are thus allowable for reasons similar to those for Claim 3.

Claim 7 is dependent back to Claim 6, and thus is allowable for at least the reasons given above for Claim 6.

Claim 10 is dependent back to Claim 9 and is thus allowable for at least the reasons Claim 9 is allowable. Claim 10 also recites, *inter alia*, “providing an extendable corner tab that permits the pop-down list to be resized by the user.” The Office Action bases its rationale for an obviousness rejection on common knowledge in the art or “well-known” prior art. In the event the § 103 rejection is maintained, the examiner is requested to cite supporting evidence, as required by MPEP § 2144.03.

Independent claim 11 also recites, *inter alia*, “providing the user with an option to globally disable future storage of field data values.” The Office Action bases its rationale for an obviousness rejection on one of ordinary skill in the art being motivated to combine the teachings of Light et al. with those of Kikinis, and then to go beyond the teachings of both references. The Office Action

states that neither Kikinis nor Light et al. teaches the claimed limitation. Thus, even if the references were combined, all of the claim limitations are not taught or suggested by the combined references. In *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed Cir. 2002), in vacating a rejection of claims based on a conclusory determination of obviousness, the Federal Circuit stated, “[o]ur case law makes clear that the best defense against the subtle, but powerful, attraction of hindsight-based obviousness analysis is a rigorous application of the requirement of a showing of the teaching or motivation to combine prior art references.” *Id.* at 1433 (*quoting In re Dembicza*k, 175 F.3d 994, 999 (Fed Cir. 1999)). Further, the legal standard requires that “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the matter claimed. *Id.* at 1433 (*quoting In re Kotzab*, 217 F.3d 1365, 1371 (Fed Cir. 2000)). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claim 11 is allowable for these reasons as well.

Independent Claim 13 also recites, *inter alia*, “detecting a password field and, upon detecting such a field, forcing the user to select whether a data value for that field will be stored for later use.” The Office Action states that Kikinis does not teach this claim limitation, and does not indicate that Light et al. does. Thus, all of the claim limitations are not taught or suggested by the reference(s). The Office Action bases its rationale for an obviousness rejection on HTML 4.0 providing a form attribute element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed. However, masking characters is not the same as “forcing the user to select whether a data value for that field will be stored for later use,” as recited in the claim. HTML 4.0 does not prompt a user nor does it save a password for future use.

Independent claim 14 also recites, *inter alia*, “performing numerical processing on the field to determine whether the field represents a credit card number and, in response thereto, suppressing suggestions.” The Office Action states that Kikinis does not teach this claim limitation, and does not indicate that Light et al. does. Thus, all of the claim limitations are not taught or suggested by the reference(s). The Office Action bases its rationale for an obviousness rejection on HTML 4.0 providing a form attribute element attribute for specifying a password field so that password characters would be masked when typed into a form field and displayed. The Office Action suggests

that such masking could have been applied to credit card numbers as well. Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. In addition, masking characters is not the same as suppressing suggestions as recited in the claim.

Claim 15 also recites, *inter alia*, “comparing the field identifier of the selected field to previously stored field identifiers that reside on a web site different from the computer on which the form is displayed.” In the claimed invention, the previously stored identifiers may reside on a web site different from the computer on which the form is displayed; they did not merely originate from a web site different from the computer on which the form is displayed. Neither Kikinis nor Light et al. teaches or suggests this claimed element. Claim 15 is thus allowable for this reason as well.

Claims 22-27 are dependent back to claim 21, and thus are allowable for at least the reasons given above for Claim 21.

Claim 28 is dependent back to claim 21, and thus is allowable for at least the reasons given above for Claim 21. Claim 28, as with Claim 15, also recites, *inter alia*, “comparing the field identifier of the selected field to previously stored field identifiers that reside on a web site different from the computer on which the form is displayed.” Claim 28 is thus also allowable for reasons similar to those for Claim 15 as well

Claim 34 is dependent back to claim 33, and thus is allowable for at least the reasons given above for Claim 33.

Claim 37 is dependent back to Claim 36 and thus allowable for at least the reasons Claim 36 is allowable. Claim 37, as with Claim 10, also recites, *inter alia*, “providing an extendable corner tab that permits the pop-down list to be resized by the user.” Claim 37 is thus allowable for reasons similar to those for Claim 10 as well.

Claim 38, as with Claim 11, also recites, *inter alia*, “providing the user with an option to globally disable future storage of field data values.” Accordingly, Claim 38 is also allowable for reasons similar to those for Claim 11 as well.

Independent Claim 40, as with Claim 13, also recites, *inter alia*, the step of “detecting a password field and, upon detecting such a field, forcing the user to select whether a data value for

that field will be stored for later use.” Accordingly, Claim 40 is also allowable for reasons similar to those for Claim 13.

Independent Claim 42, as with Claim 15, also recites, *inter alia*, “comparing the field identifier of the selected field to previously stored field identifiers that reside on a web site different from the computer on which the form is displayed.” Claim 42 is thus also allowable for reasons similar to Claim 15.

Claim 43 also recites, *inter alia*, “detecting a password field and, upon detecting such a field, inhibiting display of suggested data values for password fields unless the URL from which the form was generated matches a previously stored URL.” The Office Action concedes that Kikinis does not teach this claim limitation, and does not indicate that Light et al. teaches it. Thus, all of the claim limitations are not taught or suggested by the reference(s). Furthermore, the Office Action provides no suggestion to combine or modify the reference(s). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claim 43 is also allowable these reasons as well.

Claim 46 also recites, *inter alia*, “detecting that the one selected field is a username field and, in response to the user selecting a suggested username, automatically copying a password previously used in response to the username into a password field.” The Office Action states that Kikinis does not teach this claim limitation, and does not indicate that Light et al. teaches it. Thus, all of the claim limitations are not taught or suggested by the reference(s). Furthermore, there is no suggestion to combine or modify the reference(s). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claim 46 is also allowable for these reasons as well.

Claim 47 depends back to claim 46 and is thus allowable for the same reasons as Claim 46. Claim 47, similarly to Claim 43, also recites, *inter alia*, “matching a URL associated with the form to a previously stored URL and, in response to match failure, inhibiting the copying of the password.” Accordingly, Claim 47 is also allowable for reasons similar to those for Claim 43 as well.

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Claim 50 depends back to Claim 21 and is thus allowable for at least the reasons given for Claim 21. Claim 50, as with Claim 46, also recites, *inter alia*, "detecting that the one selected field is a username field and, in response to the user selecting a suggested username, automatically copying a password previously used in response to the selected username into a separate password field on the web page." Accordingly, Claim 50 is also allowable for reasons similar to Claim 46 as well.

Claim 51 depends back to Claim 50 and is thus allowable for at least the same reasons as Claim 50. Claim 51, similarly to Claim 43, also recites, *inter alia*, "matching a URL associated with the web page to a previously stored URL and, in response to a match failure, inhibiting the copying of the password." Accordingly, Claim 51 is also allowable for reasons similar to those for Claim 43 as well.

Claim 52, as with Claim 46, also recites, *inter alia*, "detecting that the one selected field is a username field and, in response to the user selecting a suggested username, automatically copying a password previously used in response to the selected username into a separate password field on the form." Accordingly, Claim 52 is allowable for reasons similar to Claim 46 as well.

Claim 53 depends back to Claim 52 and is thus allowable for at least the same reasons as Claim 52. Claim 53, similarly to Claim 43, also recites, *inter alia*, "matching a URL associated with the form to a previously stored URL and, in response to a match failure, inhibiting the copying of the password." Accordingly, Claim 53 is allowable for this reasons similar to Claim 43 as well.

Claim 54 also recites, *inter alia*, "detecting that the one selected field is a password field and, in response thereto, determining whether the user has previously indicated whether a password should be stored for a URL on which the form resides and, if no such previous indication was made, prompting the user to indicate whether the password field should be stored for that URL." The Office Action states that Kikinis does not teach this claim limitation, and does not state that Light et al. teaches it. Thus, all of the claim limitations are not taught or suggested by the reference(s). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claim 54 is allowable for this reason as well.

Claims 5, 23, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

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Kikinis in view of Light et al. and further in view of U.S. Patent No. 6,199,079 to Gupta et al., issued March 6, 2001. Applicants respectfully traverse this rejection for at least the following reasons.

Claims 5 and 32, as with Claim 3, recite, *inter alia*, “displaying a list of suggested data values previously stored in response to one or more different forms previously filled in by the user; in response to the user selecting one of the suggested data values, copying the data value selected by the user into the data entry region of the selected field.” Claims 5 and 32 are thus allowable for reasons similar to those for Claim 3.

Claim 5 also recites, *inter alia*, “comparing the field identifier of the selected field to previously stored field identifiers having the same URL and, upon finding a match, displaying suggested data values having the same URL.” The Office Action states that Kikinis does not teach the claimed limitation, and that Gupta et al. teaches a form’s URL as a criterion for selecting form data. However, Gupta does not teach “displaying suggested data values having the same URL” from which the user can choose. Thus, even if the references were combined, all of the claim limitations are not taught or suggested by the combined references. Accordingly, Claim 5 is allowable for these reasons as well.

Claim 23 is dependent back to Claim 21 and is thus allowable for at least the reasons for Claim 21. Claim 23, as with Claim 5, recites, *inter alia*, “comparing the field identifier of the selected field to previously stored field identifiers having the same URL and, upon finding a match, displaying suggested data values having the same URL.” Claim 23 is thus allowable for reasons similar to those for Claim 5 as well.

Independent Claim 32, as with Claim 5, recites, *inter alia*, “comparing the field identifier of the selected field to previously stored field identifiers having the same URL and, upon finding a match, displaying suggested data values having the same URL”. Claim 32 is thus allowable for reasons similar to those for Claim 5 as well.

Claims 8, 25, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of Light et al. as applied to claims 7, 21, and 33, respectively, above, and further in view of applicant’s specification. Applicants respectfully traverse this rejection for at least the following reasons.

Claims 8, 25, and 35 are allowable based on the allowability of their respective base claims.

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In addition, claims 8, 25, and 35 recite, *inter alia*, “comparing the field identifier of the selected field to field identifiers in a statically created standard vCard schema, wherein the field identifiers in the vCard schema are mapped to one or more field identifiers in the common names data store.” The Office Action states that Kikinis does not teach this claim limitation. Applicants disclose that the standard vCard schema was known in the art prior to the claimed invention. However, there is no suggestion to combine the references. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680 (Fed.Cir 1990)). In addition, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, *not in applicant’s disclosure*. MPEP § 2143 (*citing In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)) (emphasis added). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claims 8, 25, and 35 are allowable for this reason as well.

Claims 16-17, 19-20, 48-49, and 55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Light et al. in view of U.S. Patent No. 5,666,502 to Capps, issued September 9, 1997. Applicants respectfully traverse this rejection for at least the following reasons.

Claim 16 recites, *inter alia*, “detecting that one of the text fields on the second form is correlated with one of the text fields on the first form despite having a different field identifier and, in response thereto, retrieving a corresponding previously stored data value from the local storage area.” The Office Action states that Light et al. teaches the claimed limitation. However, in Light et al., col. 6, lines 61-67, cited in the Office Action, the system is in a learning mode, where it first looks to see if the user entered a previously stored data value manually for a field identifier that has not already been stored in the database, and then updates the database to include the new field identifier. Thus, Light et al. does not first detect a correlation between field identifiers and then retrieve a previously stored data value from the local storage area in response thereto. Therefore, Light et al. does not teach or suggest the claimed limitation, and Claim 16 is allowable. Claim 16 also recites, *inter alia*, “suggesting the data value retrieved in step (4) to the user as a possible value to be entered into the second form.” Because Light et al. does not retrieve a data value from local

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storage as recited in the claim, discussed above, it cannot then suggest the data value to the user, even if suggested by Capps. There is no data value to suggest, as the user in Light et al. has already entered a data value manually. Thus, all of the claim limitations are not taught or suggested by the prior art references, and Claim 16 is allowable for this reason as well.

Claims 17, 19, 20, 48, and 55 are dependent back to Claim 16 and are thus allowable for at least the same reasons as for Claim 16.

In addition, claim 48, as with Claim 46 recites, *inter alia*, “detecting that one of the text fields on the second form is a username field and, in response to the user selecting a suggested username, automatically copying a password previously used in response to the selected username into a separate password field on the second form.” Accordingly, Claim 48 is also allowable for reasons similar to Claim 46.

Claim 49 is dependent back to claim 48 and is thus allowable for at least the same reasons as for Claim 48. Claim 49, similar to Claim 43, also recites, *inter alia*, “matching a URL associated with the second form to a previously stored URL and, in response to a match failure, inhibiting the copying of the password.” Accordingly, Claim 49 is also allowable for these reasons similar to those for Claim 43.

Claim 55, as with Claim 54, also recites, *inter alia*, “detecting that the one text field is a password field and, in response thereto, determining whether the user has previously indicated whether a password should be stored for a URL on which the form resides and, if no such previous indication was made, prompting the user to indicate whether the password field should be stored for that URL.” Accordingly, Claim 55 is also allowable for reasons similar to those for Claim 54.

Claim 18 stands rejected under 35 U.S.C § 103(a) as unpatentable over Light et al. in view of Capps as applied to claim 16 above, and further in view of Applicants’ specification. Applicants respectfully traverse this rejection for at least the following reasons.

Claim 18 depends back to Claim 16 and is allowable for at least the reasons for Claim 16. Claim 18 also adds the step of using Bayesian inference techniques. The Office Action concedes that neither Light et al. nor Capps teach using Bayesian inference techniques. Applicants disclose that Bayesian techniques were known in the art prior to the invention. However, there is no suggestion to combine or modify the references other than in Applicants’ own disclosure. “The mere

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fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680 (Fed.Cir 1990)). In addition, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. MPEP § 2143 (*citing In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)). Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claims 18 is allowable.

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of Light et al. and further in view of Capps. Applicants respectfully traverse this rejection for at least the following reasons.

Applicants respectfully submit that that there is no motivation or suggestion to combine Kikinis, which discloses a system for filling in fields on forms on the World Wide Web (WWW) by associating specific pre-stored data values with field names, with Capps, which discloses a data input technique for a proprietary, hand-held personal organizer. Kikinis describes a system that allows a user to link specific pre-stored data, usually data unique to the user, with fields in forms encountered on the Internet. *See Kikinis*, col 1, lines 45-50. By contrast, the personal organizer disclosed in Capps is not connected to the Internet, and only encounters forms provided by and under the control of the program code on the proprietary personal organizer itself. *See Capps*, figs. 13A and 13B, for example. Furthermore, the data values in Capps are not specific, pre-stored data values that are unique to the user. Capps instead manages data values that the user previously entered on proprietary forms, regardless of their uniqueness and specificity to the user.

In addition, claim 45 recites, *inter alia*, “wherein the computer-executable instructions permit the user to delete one of the previously stored suggested data values.” The Office action states that neither Kikinis nor Capps teaches allowing the user to delete one of the previously stored suggested data values. A finding of obviousness is based on Capps teaching removing the least recently used item from a history list when the list has reached maximum size. Thus, even if the references were combined, all of the claim limitations are not taught or suggested by the combined references. Applicants respectfully request the rejection be withdrawn, as it is improper. The Office Action

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relies on conclusory statements and provides no particular reason or motivation to arrive at the claimed invention. Accordingly, Claim 45 is allowable for this reason as well.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 16th day of September, 2003 By:


Ross Dannenberg, Registration No. 49,024

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001
RAD/mmd

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